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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,408

11/25/2003

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02/12/2008

EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,408	Applicant(s) SNOWDEN ET AL.	
	Examiner Andrew T. Piziali	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,25,28-31,33-37,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,25,28-31,33-37,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

1. The response filed on 1/7/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 23, 25, 28-31 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson.

Regarding claims 23, 25, 28-31 and 34-37, Potts discloses a topically treated (treated on the surface of the fibers) nonwoven fabric laminate comprising a repellant agent (see entire document including column 17, line 62 through column 18, line 5). Potts discloses that the nonwoven fabric may be a spunbond and meltblown fabric laminate (column 17, line 62 through column 18, line 5). Potts specifically discloses that “at least one melt-extruded nonwoven layer” of a two layer nonwoven fabric laminate is prepared in the disclosed manner resulting in the agent on the surface of the fibers (column 6, lines 6-33). Therefore, Potts discloses that all layers of the laminate may be prepared as disclosed. In the event that it is shown that Potts does not disclose the claimed embodiment with sufficient specificity, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare all the layers with the repellant agent, because some applications require a laminate with repellant characteristics throughout the laminate.

Potts discloses that the repellant may be any of a variety of fluoropolymers (column 13, lines 27 through column 14, line 37), but Potts does not specifically disclose whether any of the fluoropolymers are non-ionic. Simpson discloses that ZEPEL 7040 is a non-ionic fluoropolymer repellant additive that is known in the repellant nonwoven fabric art (see entire document including column 10, lines 55-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the repellant additive from any suitable repellant material, such as a non-ionic fluoropolymer, such as ZEPEL 7040, as taught by Simpson, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Potts does not appear to disclose the method disclosed in the current specification (applying the composition in an aqueous solution and then drying to remove the water), but Potts does disclose that the composition ends up on the surface of the fibers (without the presence of water), by migration upon formation, and that the fabric is then subjected to heat (column 6, lines 6-40). Potts specifically discloses that the additive completely covers the surface of the fiber as the segregation proceeds to completion (column 10, lines 20-32). Absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an

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unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding claim 25, Potts discloses that the nonwoven fabric may be a medical fabric (column 17, lines 47-61).

Regarding claims 28-31 and 34-36, Potts does not disclose the specific hydrostatic head value or alcohol repellency of the treated nonwoven fabric, but considering that the fabric taught by the applied prior art is identical to the claimed treated nonwoven fabric (spunbond/meltblown/spunbond laminate coated on one surface with an antistatic agent and the other surface with a non-ionic fluoropolymer repellant), it appears that the fabric inherently possesses the claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

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4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson as applied to claims 23, 25, 28-31 and 34-37 above, and further in view of any one of USPN 4,000,233 to Gilbert or USPN 4,169,062 to Weipert.

Potts discloses that an antistatic agent may be present in combination with the repellant agent (column 10, lines 33-47). Potts does not specifically mention an organic phosphate ester antistatic agent, but Gilbert and Weipert each disclose that it is known in the antistatic art to use an organic phosphate ester antistatic agent (see entire documents including column 1, lines 12-38 of Gilbert and Table II of Weipert). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the antistatic agent from any suitable antistatic composition, such as an organic phosphate ester, as taught by Gilbert and Weipert, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

5. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson as applied to claims 23, 25, 28-31 and 34-37 above, and further in view of (to show inherency) USPN 5,296,282 to Evers.

Simpson discloses that ZEPEL 7040 is a known non-ionic fluoropolymer repellant, but Simpson does not appear to disclose the specific composition of ZEPEL 7040. Evers discloses that ZEPEL 7040 is a well-known perfluoroalkylethylacrylate repellent material (see entire document including column 3, lines 50-68).

Response to Arguments

6. Applicant's arguments filed 1/7/2008 have been fully considered but they are not persuasive.

Potts discloses that the additive in one layer “must not migrate to an adjacent layer” so that the surface characteristics of each layer remain substantially as originally prepared (column 14, lines 51-55). Based on this disclosure, the applicant jumps to the conclusion that all layers must not contain the same additive. The examiner respectfully disagrees. There is a difference between no migration occurring between adjacent layers compared to adjacent layers intentionally comprising the same additive. Although Potts teaches that migration “must not” occur between adjacent layers due to the disclosed method, Potts clearly discloses multiple embodiments wherein adjacent layers contain the same additive (e.g., see the paragraph bridging columns 17 and 18). The “must not” is simply referring to what the process inherently does not allow. In other words, “must not” means “can’t.” The phrase does not preclude the use of other methods to obtain the same additive in adjacent layers.

Potts specifically discloses that “at least one melt-extruded nonwoven layer” of a two layer nonwoven fabric laminate is prepared in the disclosed manner resulting in the agent on the surface of the fibers (column 6, lines 6-33). Therefore, Potts discloses that all layers of the laminate may comprise the same additive.

In addition, the problem motivating the patentee (Potts) may be only one of many addressed by the patent’s subject matter. The question is not whether the combination was obvious to the patentee (Potts) but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of

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endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed. See **KSR v. Teleflex**. Therefore, even in the event that it is determined that Potts does not disclose the claimed embodiment with sufficient specificity, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare all the layers with the repellant agent, because some applications require a laminate with repellant characteristics throughout the laminate.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1794